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Michael S. Zaharkin

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SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

P.O. BOX 2938

MINNEAPOLIS, MN 55402

EXAMINER

BASEHOAR, ADAM L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/023,440	Applicant(s) ZAHARKIN, MICHAEL S.	
	Examiner ADAM L. BASEHOAR	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-15, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 13, 14 and 34 is/are allowed.
- 6) ☒ Claim(s) 15 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 05/22/08.
2. Claim 10 has been cancelled as necessitated by Amendment.
3. The rejection of claim 14 under 35 U.S.C. 101 has been withdrawn as necessitated by Amendment.
4. The various rejections to claims 9, 14, and 34 have been withdrawn as necessitated by Amendment.
5. Claims 1-9, 13-15, 33-34 remain selected for examination of the merits. Claims 1, 9, 13, 14, 33, 34 are independent claims.

Claim Objections

6. Claim 15 is objected to because of the following informalities: Claim 15 currently depends from “the system of claim 13”. However independent claim 13 is in fact a computer readable medium type claim. The Examiner suggests that dependent claim 15 should be amended to properly depend from independent system claim 14. If dependent from claim 14, the Examiner notes that the “means for” language in claim 15 should also be amended to reflect the newly added limitations to independent claim 14 (i.e. deleting the “means for” language). Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 contains the trademarks/trade names IBM, SUN, SUN Ultra, and SUN Ultra Server. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a server and/or personal computer and, accordingly, the identification/description is indefinite. The Examiner suggests that the trademarks be removed from the claims (e.g. "parts of a mainframe computer or within a server or within a personal computer.")

Allowable Subject Matter

9. Claims 1-9, 13, 14, and 34 are allowed.

10. As disclosed above, the indicated allowability of claim 15 is withdrawn in view of the newly applied claim objection as well as the newly applied 35 U.S.C. 112, second paragraph, rejection.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wanderski (US-6,519,617 02/11/03) in view of Yamakawa et al. (US-5,907,851 05/25/99).

In regard to independent claim 33, Wanderski discloses transformation (using software) for converting an XML document with a selected DTD into a new transformed document reflective of an XML dialect (Wanderski: column 1, lines 51-67; column 2, lines 1-7; column 4 lines 25-42: “subsequently be processed by an XML parser for the desired manner of presentation”; column 14, lines 43-52). A plurality of DTDs are generated, as needed, so that a document (an output file) will conform to its new DTD accordingly (Wanderski: column 11, lines 60-67; column 14, lines 43-52). In this fashion, various documents are “disambiguated” via compliance with their respective (different) DTDs, changing all, or portions of documents as necessary (column 1, lines 51-67; column 2, lines 1-7).

Wanderski does not specifically teach providing a set of two or more DTDs, and selecting one for conversion. However, Yamakawa teaches document conversion utilizing preparation of a plurality of document type definitions (DTDs) for switching and development of one or more DTDs (Yamakawa: column 22 lines 22-32: “plurality of portions can be selected by the editor are present”, Figure 67). It would have been obvious to one of ordinary skill in the art

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at the time of the invention to apply Yamakawa to Wanderski, providing Wanderski the benefit of predefined DTD selection for eventual adherence to various established standards (column 4, lines 53-55: "efficiently processed"; column 22, lines 23-32: "the document type definitions are processed by the number of the document elements that can be selected so as to be selected").

Response to Arguments

13. Applicant's arguments filed 05/22/08 have been fully considered but they are not persuasive.

Applicant argues that the proposed motivation (regarding claim 33) is not applicable to Wanderski. The examiner respectfully disagrees. Yamakawa teaches document conversion utilizing preparation of a plurality of document type definitions (DTDs) for switching and development of one or more DTDs. Applying this teaching to Wanderski provides Wanderski the benefit of either generating new DTDs or selecting from predefined DTDs for eventual adherence to various established standards.

In general the Examiner notes that the Wanderski reference teaches the common well-known principles of applying DTDs to specific documents for the purpose of telling a parser how to interpret said document (column 1, lines 51-67; column 2, lines 1-7). Specifically, the background of Wanderski teaches that specific document types would require specific DTDs for efficient and correct processing (e.g. DTD for documents of type "memo"). Thus Wanderski shows a need to be able to select a specific type of DTD for a given document type. The selection of such a DTD, depending on the document type, is not considered a novel feature in view of the applied prior art combination and in general to one of ordinary skill in the art at the

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time of the invention. The Wanderski reference specifically teaches the selection of the dynamically created DTD for use in processing the document (column 4, lines 35-39; column 14, lines 43-47).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Please note the additional references cited on the accompanying PTO-892 form.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM L. BASEHOAR whose telephone number is (571)272-4121. The examiner can normally be reached on M-F: 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam L Basehoar/
Primary Examiner, Art Unit 2178